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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/213,544 12/17/98 NARDI

J EVE01-P-565-

EXAMINER

IM22/1208

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ART UNIT

PAPER NUMBER

1745

DATE MAILED:

12/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/213,544

Applicant(s)
Nardi

Examiner
Carol Chaney

Group Art Unit
1745



☒ Responsive to communication(s) filed on 12-17-98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mototani et al. (US Patent 5,482,798).

Applicants' invention is essentially directed to alkaline batteries with cathodes containing manganese dioxide and expanded graphite. Mototani et al. disclose alkaline manganese batteries containing manganese dioxide and expanded graphite. (Note column 3, lines 40-52.)

The disclosure of Mototani et al. differs from applicants' claims in that Mototani et al. do not disclose kerosene absorption values, surface areas, or densities of the expanded carbons used. Additionally, Mototani et al. do not disclose the identical particle size ranges and distributions claimed by the applicants.

However, because Mototani et al. disclose the internal resistance and discharge of inventive batteries vary with expanded graphite size and expanded graphite content, it would have been obvious to one of ordinary skill in the art to optimize the sizes of the expanded graphite used and the amount of graphite used for a particular application. However, without a showing of

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results which are different in kind, and not merely in degree, from those of the prior art, applicants' invention is not distinguished. Claims that differ from the prior art only by slightly different (non-overlapping) ranges are prima facie obvious without a showing that the claimed range achieves unexpected results relative to the prior art. See *In re Woodruff*, 16 USPQ2d 1935,1937 (Fed. Cir. 1990.) The claimed ranges of a result effective variable, which do not overlap the prior art ranges, are unpatentable unless they produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. See *In re Huang*, 40 USPQ2d 1685 (Fed. Cir. 1996) The discovery of optimums of result effective variables in known processes is ordinarily within the skill of art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980) The selection of optimum ranges within prior art general conditions is obvious. See *In re Aller*, 105 USPQ 233(CCPA 1955).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jose et al., US Patent 5,919,588; Hashimoto et al., US Patent 5,772,930; Maryasin et al., US Patent 5,282,975.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol Chaney whose telephone number is (703) 305-3777. The examiner can normally be reached on Monday-Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Maria Nuzzolillo, can be reached on (703) 305-3776. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Carol Chaney
Patent Examiner
Art Unit 1745
December 3, 1999